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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,094	10/16/2003	Darshan Kumar	OIC0245US	9094
60975 7590 12/11/2008 CAMPBELL STEPHENSON LLP 11401 CENTURY OAKS TERRACE BLDG. H, SUITE 250 AUSTIN, TX 78758			EXAMINER DANNEMAN, PAUL	
			ART UNIT 3627	PAPER NUMBER
			MAIL DATE 12/11/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/688,094	<b>Applicant(s)</b> KUMAR ET AL.	
	<b>Examiner</b> PAUL DANNEMAN	<b>Art Unit</b> 3627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### Response to Amendment

1. This action is in reply to Applicant's response filed on 29 August 2008, to the first office action.
2. Claims 1-3, 10, 13, 14 and 22 have been amended.
3. Claims 1-28 are pending in the application and have been examined.

### Response to Arguments

4. The Examiner thanks the Applicant for providing the corrected drawings and respectfully withdraws the objection to the drawings.

5. Applicant argues, regarding the 35 USC § 101 rejection of Claims 10, 11 and 12 that ***"Applicants respectfully submit that the claimed data structure stored on a machine readable is usable to perform specific functions that produce tangible results. Further, claim 10 has been amended to recite that the data structure is configured to be used in translating invoice adjustment information, which produces a useful, concrete, and tangible result."*** The Examiner has carefully reviewed MPEP § 2106.01, applicant's argument and amendment and respectfully must disagree. What Examiner once thought was executable code is really non-executable code stored on a machine readable medium as stated by applicant's amendment. The data of the data structure is configured to be used therefore it is really non-functional descriptive material. The MPEP §2106.01 states **"When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. See >Diamond v.< Diehr, 450 U.S. \*>175,< 185-86, 209 USPQ \*>1,< 8 (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer.").** Such a

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result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) (“[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under § 101, the claimed invention, as a whole, must be evaluated for what it is.”) (quoted with approval in Abele, 684 F.2d at 907, 214 USPQ at 687). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) (“form of the claim is often an exercise in drafting”). “Therefore, the rejection of Claims 10, 11 and 12 under 35 USC § 101 is maintained.

6. The rest of the arguments are directed towards the amended claims and responses are in the Claim Rejections - 35 USC § 103 section.

***Claim Rejections - 35 USC § 101***

7. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. **Claims 10, 11, and 12** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 10, 11 and 12 have a data structure stored on a machine-readable medium which does not produce a useful, concrete and tangible result.

***Claim Rejections - 35 USC § 103***

9. **Claims 1-28** are rejected under 35 U.S.C. 103(a) as being unpatentable over Knauss et al., US 7,043,687 B2 hereafter know as Knauss.

**Claims 1, 13 and 22:**

With regard to the limitations:

- ***Receiving invoice adjustment information in an application-specific data object format from various software applications;***
- ***Receiving configuration information related to the software applications is received at a transport layer;***
- ***Translating the invoice adjustment information into a common invoice adjustment data object format;***

Knauss in at least Fig.3, Fig.4, Fig.5, Fig.9 and Column 2, lines 22-44 discloses a computer implemented method of automatically generating Electronic Data Interchange (EDI) documents or messages. The method includes receiving a source data model corresponding to EDI related data; the source data model includes metadata, mapping the metadata of the source data model to corresponding variables of a virtual document, and mapping the variables of the virtual document to metadata of a target data model. Once the variables are mapped (translated) the associated values of the mapped variables of the virtual document are then provided to the corresponding metadata of the target data model, in order to populate a target document or message with data from the source document or message. Knauss in at least FIG.3, Column 5, lines 64-67, and Column 6, lines 1-12 discloses a virtual document interface between applications and various types of messages or documents. Each application has a link to the virtual document interface, in which previously-defined mappings to variables of the virtual document are utilized in order to populate a target document or message, from a source document or message. Knauss in at least Column 6, lines 13-20 further discloses a system and method enabling automatic translation of EDI data to or from a self-describing markup language format such as XML, or an XML dialect, by way of a virtual document. Knauss in at least Column 5, lines 38-48 still further discloses that an EDI message is a data element and may be an invoice or purchase order. That way an invoice or advance shipping notice can be taken from one source and converted to a format compatible with the second source. Knauss in at least Column 9, lines 48-58 and Column 10, lines 1-3 further discloses that under control of the translator, values are written into the variables of the virtual document from the source data model in a data stream from the source

data model to the target data model. Knauss in at least Column 9, lines 59-67 still further discloses that multiple target documents may be populated using data obtained from a single source document.

- ***Translating is comprised of accessing a first storing unit configured to store transformation information;***
- ***Accessing a second storing unit configured to store defined business processes; and***
- ***Using a business process controller configured to execute the business processes, wherein the execution is in response to predefined events.***

Knauss in at least Column 9, lines 44-47 discloses that the data may be written to a writable memory or other types of writable memory devices, as is known to those skilled in the art.

Knauss in at Fig.10, Fig.11 and Column 9, lines 11-58 documents the business processes for translating one document object format to another format.

**Examiner's Note:** Claim limitations that employ phrases of the type "Capable of or Configured to" are intended use limitations which may not distinguish over the prior art. It has been held that the recitation that an element is "capable of" performing a function is not a positive limitation, but only requires the ability to perform. MPEP 21114 and Ex parte Masham, 2 USPQ2d 1647 (1987)

**Claims 2-9, 14-21 and 23-28:**

Regarding the limitations:

- ***Interchanging invoice adjustment information between software applications,***
- ***Translating the invoice adjustment information into a format useable by the receiving software application,***
- ***The invoice adjustment data uses extensible markup language format,***

Knauss in at least Column 6, lines 13-20 further discloses a system and method enabling automatic translation of EDI data to or from a self-describing markup language format such as XML, or an XML dialect, by way of a virtual document. Knauss in at least Column 5, lines 38-48

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still further discloses that an EDI message is a data element and may be an invoice or purchase order. Each data element may represent a singular fact, such as a price, product, model number, and so forth.

Knauss in at least FIG.4 and Column 6, lines 36-51 further discloses links or mappings to the variables of a virtual document and to and from the source data model and the target data model.

Knauss in at least Column 9, lines 48-58 and Column 10, lines 1-3 further discloses that under control of the translator, values are written into the variables of the virtual document from the source data model in a data stream from the source data model to the target data model. Knauss in at least Column 9, lines 59-67 still further discloses that multiple target documents may be populated using data obtained from a single source document.

- ***Determining essential data elements from one format and converting to a another format,***
- ***Essential data elements include identification, invoice adjustment, billing, status, and a list of invoice adjustment line item detail elements.***

Knauss does not specifically disclose the essential data elements as being identification, invoice adjustment, billing, status, and a list of invoice adjustment line item type of elements. However, Knauss in at least Fig.6 and Column 10, lines 43-63 discloses identifying the source elements and mapping them to the destination elements. Therefore, it would have been obvious, at the time of the invention, to one of ordinary skill to modify Knauss to include those essential data elements (identification, invoice adjustment, billing, status, and a list of invoice adjustment line item detail elements, employee data element, invoice element, and a comments element) with the motivation of insuring that all important data from the source document is mapped to the proper location in the destination document.

### **Conclusion**

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to PAUL DANNEMAN whose telephone number is (571)270-1863. The examiner can normally be reached on Mon.-Thurs. 6AM-5PM Fri. off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Florian Zeender can be reached on 571-272-6790. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Paul Danneman/

Examiner, Art Unit 3627

5 December 2008

/F. Ryan Zeender/

Supervisory Patent Examiner, Art Unit 3627